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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,204	09/19/2001	Syuichi Ikenoue	KATA-170	8671

7590 07/03/2003

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EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/955,204

Applicant(s)
S. IKENOUE et al.

Examiner
Kishor Mayekar

Art Unit
1753



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) 5-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2, 5 & 7 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 and 10-12, drawn to a multi-layer coating film-forming method, classified in class 204, subclass 484.
- II. Claims 5-9, drawn to a multi-layer coating film forming method, classified in class 204, subclass 484.

2. The inventions are distinct, each from the other because of the following reasons: Inventions of Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects: Group I has a step of coating a composition which is different

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from that of Group II.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Attorney V. Marsh on June 24, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-4 and 10-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by

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a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Objections

6. Claim 2 is objected to because of the phrase "so as". It needs to be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102 and § 103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly by GB 2,334,222 A, a reference cited by Applicant. GB '222's invention is directed to a method of forming a multi-layer coating film which comprise coating a cationic electrodeposition coating composition containing a blocked polyisocyanate compound as a crosslinking agent (page 3, lines 12-20), coating a water based intercoat coating composition containing a hydroxyl group and carboxyl group-containing resin, a blocked polyisocyanate crosslinking agent (page 4, lines 18-35), a fine aluminum powder and titanium oxide pigment (see abstract) and heat curing both coating films simultaneously (page 3, lines 34-36). As to the recited white pigment of titanium oxide, titanium oxide of GB '222 inherently possesses the white pigment.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB '222.

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GB '222 further discloses in paragraph crossing pages 4 and 5 the average particle size of the fine aluminum powder. The difference between GB '222 and the instant claim is the overlapping of the mean particle size of the fine aluminum powder. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified GB '222's teachings because it has been held that a prima case of obviousness exists where claimed ranges overlap or lie inside ranges disclosed by the prior art, *In re Wertheim* 191 USPQ 90; *In re Woodruff* 16 USPQ 1934.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB '222 in view of DOEBLER et al. (5,389,406). The difference between GB '222 and the instant claim is the reciting controlling. DOEBLER shows the controlling of curing temperature in a process for the production of multilayer coatings (see abstract). The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified GB '222's teachings as suggested by DOEBLER in a two-coat-one bake process because this would result in

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coatings with good intermediate layer bonding, improved subsequent processability, and good, defect-free surface structure.

12. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '222 in view of KERLIN et al. (5,702,581). GB '022 further discloses in the last paragraph of page 2 that "in the process any usual undercoat paint can be used". The difference between GB '222 and the instant claims is the use of a lead-free cationic electrodeposition coating composition containing a bismuth-containing compound. KERLIN shows the use of such a coating composition (see abstract). The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified GB '222's teachings as suggested by KERLIN because the selection of any of known equivalent undercoat paint would be within the level of ordinary skill in the art.

13. Claims 2 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '222 in view of TOMIZAKI et al. (6,375,820). GB '022 further discloses

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in the last paragraph of page 2 that "in the process any usual undercoat paint can be used". The differences between GB '222 and the above claims are the controlling of the curing temperature and the use of a lead-free cationic electrodeposition coating composition containing a bismuth-containing compound. TOMIZAKI both the limitations in a process for forming multilayer coating film (col. 6, lines 17-41 and col. 4, line 53 through col. 5, line 62). The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified GB '222's teachings as suggested by TOMIZAKI because the selection of any of known equivalent cationic electrodeposition coating composition would be within the level of ordinary skill in the art.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-0477. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM.

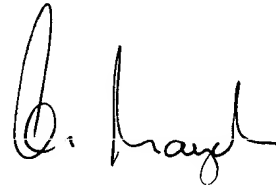
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on (703) 308-3322. The fax phone number for this Group is (703) 872-9310 (non-after finals) or 872-9311 (after final).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'K. Mayekar', with a stylized, cursive script.

Kishor Mayekar
Primary Examiner
Group 1700

KM

June 28, 2003